



UNITED STATES DEPARTMENT OF COMMERCE
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NOTICE OF ALLOWANCE AND ISSUE FEE DUE

18M2/1016

NORVAL B. GALLOWAY
AMOCO CORP.
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FOUNTERS GROVE II, 60515

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
08/238,080	05/03/94	040	REES, D	1807 10/16/97

TITLE OF INVENTION COLLINS, MARK L.

TARGET AND BACKGROUND CAPTURE METHODS WITH AMPLIFICATION FOR AFFINITY ASSAYS

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
2383511	433-006.000	118	UTILITY	NO	\$1320.00	01/16/98

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

- I. Review the SMALL ENTITY status shown above.
If the SMALL ENTITY is shown as yes, verify your current SMALL ENTITY status:

If the SMALL ENTITY is shown as NO:

- A. If the status is changed, pay twice the amount of the FEE DUE shown and notify the Patent and Trademark Office of the change in status, or
B. If the status is the same, pay the FEE DUE shown above.

A. Pay FEE DUE shown above, or

B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

- II. Part B of this notice should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "6b" of Part B should be completed.

- III. All communications regarding this application must give application number and batch number.
Please direct all communication prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B—ISSUE FEE TRANSMITTAL

142-1320

MAILING INSTRUCTIONS: This form should be used in transmitting the ISSUE FEE. Blocks 2 through 6 should be completed where appropriate. All further correspondence including the Issue Fee Receipt, the Patent, advance order, and notification of maintenance fees will be mailed to the address entered in Block 1 unless you direct otherwise, by: (a) specifying a new correspondence address in Block 3 below; or (b) providing the PTO with a separate "FEE ADDRESS" for maintenance fee notifications with the payment of issue fee or thereafter. See reverse for Certificate of Mailing, below.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending on the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, D.C. 20231.

DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Box Issue Fee, Assistant Commissioner for Patents, Washington D.C. 20231

1. CORRESPONDENCE ADDRESS

NORVAL B. GALLOWAY
AMOCO CORP.
AMOCO TECHNICAL LAW DEPT.
3100 ANDERSON DRIVE
CHICAGO, ILLINOIS 60601

13M2/1016

2. INVENTOR(S) ADDRESS CHANGE (Complete only if there is a change)

INVENTOR'S NAME

Street Address

City, State and Zip Code

CO-INVENTOR'S NAME

Street Address

City, State and Zip Code

☐ Check if additional changes are enclosed

RECEIVED
Publishing Division
JAN 13 1998
04

APPLICATION NO.

FILING DATE

TOTAL CLAIMS

EXAMINER AND GROUP ART UNIT

DATE MAILED

238080

First Named Applicant

01/28/98

05/05/94

840

REES, D

1807

10/16/97

TITLE OF INVENTION

MARKING

MARK L.

TAKING AND BACKGROUND CAPTURE METHODS WITH AMPLIFICATION FOR AFFINITY

ATTY'S DOCKET NO.

CLASS-SUBCLASS

BATCH NO.

APPLN. TYPE

SMALL ENTITY

FEE DUE

DATE DUE

3. Correspondence address change (Complete only if there is a change)

01/28/1998 LBERGER 00000128 08238080

01-FC-142

1320.00 OP

4. For printing on the patent front

page, list the names of not more than 3 registered patent attorneys or agents OR, alternatively, the name of a firm having as a member a registered attorney or agent. If no name is listed, no name will be printed.

1 Norval B. Galloway

2

3

5. ASSIGNMENT DATA TO BE PRINTED ON THE PATENT (print or type)

(1) NAME OF ASSIGNEE:

AMOCO CORPORATION

(2) ADDRESS (CITY & STATE OR COUNTRY)

Chicago, Illinois

A. ☐ This application is NOT assigned.☒ Assignment previously submitted to the Patent and Trademark Office
☐ Assignment is being submitted under separate cover. Assignment should be directed to Box ASSIGNMENTS.

PLEASE NOTE: Unless an assignee is identified in Block 5, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the PTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

6a. The following fees are enclosed:

☒ Issue Fee ☐ Advance Order - # of Copies

6b. The following fees should be charged to:

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(ENCLOSE A COPY OF THIS FORM)

☐ Issue Fee ☐ Advance Order - # of Copies
☒ Any Deficiencies in Enclosed Fees

The COMMISSIONER OF PATENTS AND TRADEMARKS is requested to apply the Issue Fee to the application identified above.

(Authorized Signature)

Norval B. Galloway

(Date)

1/9/98

NOTE: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.

Certificate of Mailing

Note: If this certificate of mailing is used, it can be used to transmit the Issue Fee. This certificate cannot be used for any other accompanying papers.

Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Box ISSUE FEE

Assistant Commissioner for Patents

Washington, D.C. 20231

on: January 9, 1998

(Date)

Leslie B. Henson

(Name of person making deposit)

[Signature]

(Signature)

January 9, 1998

(Date)

Notice of Allowability

Application No.
08/238,080

Applicant(s)
Collins et al.

Examiner
Dianne Rees

Group Art Unit
1807

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☒ This communication is responsive to 7/10/97, 7/14/97.

☒ The allowed claim(s) is/are 25-50 and 53-66.

☐ The drawings filed on _____ are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☒ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.

☒ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. 22.

☐ including changes required by the proposed drawing correction filed on _____, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Interview Summary, PTO-413

☐ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☒ Examiner's Statement of Reasons for Allowance

Art Unit:

DETAILED ACTION

1. The following is an examiner's statement of reasons for allowance:

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The claims are drawn to methods of PCR amplification wherein the target is first separated from the sample by using a support that binds to the target polynucleotide and then amplified. In further embodiments of the invention a probe is contacted to a target and the target probe complexes then contacted to the support which binds to the probe and the support and complex are separated from the medium, The probe target complex is then leaved into a second medium and substantially separated from the support and the target is subsequently amplified..The instant application has priority to 10/23/86

The closest prior art is Vary et al and Henson et al. Vary et al teaches a method for amplifying and detecting a target polynucleotide in a sample comprising amplifying the target polynucleotide by primer extension, immobilizing the amplified polynucleotide on a support , separating the amplified polynucleotide and detecting said polynucleotide. Vary et al does not teach binding a target polynucleotide to the support prior to amplification and does not teach retrievable supports. Henson et al teaches general methods of isolating a target sequence of interest from a sample by immobilization onto a solid support and that the order of reaction

Art Unit:

between a single stranded nucleic acid and a probe and a support may be varied according to experimental needs. However, the art at the time of filing did not recognize that the efficiency of PCR amplification would decrease due to the presence of contaminants in a sample and therefore provided no motivation to purify a target sample from a heterogenous sample of nucleic acids prior to amplification. Having not recognized the problem, applicant's solution therefore, while utilizing routine methodology to modify PCR amplification techniques, would not have been obvious at the time that the invention was made. The Declaration of Dr. David Pershing, further supports this conclusion as providing further evidence concerning the skill of the art at the time of filing, attesting that one of skill in the art would likely stay away from combining a hybridization capture method with a PCR method since one would not be motivated to provide a method with the potential to lose target nucleic acids prior to amplification.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Serial Number: 08238080

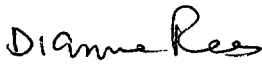
Page 4

Art Unit:

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dianne Rees whose telephone number is (703) 308-6565.

08238080-00000000


W. GARY JONES
SUPERVISORY PATENT EXAMINER
GROUP 1800
10/14/97


Dianne Rees
October 13, 1997
10/13/97